

REMARKS

I. Introduction

Claims 1-27 are pending in the application.

The specification is objected to because of informalities referring to “carbon silicon.”

Claims 2, 9-14, 20-21, 23 and 27 are rejected under 35 U.S.C. 112, 2nd para.

Claims 1-8, 15-20, and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2514793 in view of Hopkins et al (US 4,750,227).

Claims 11, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2514793 in view of Hopkins et al (US 4,750,227), in further view of Dischler (US 5,363,599).

Claims 9, 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2514793 in view of Keipert et al (US 6,645,263).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2514793 in view of Keipert et al (US 6,645,263), in further view of Hopkins et al (US 4,750,227).

II. Amendments

The specification has been amended as noted above.

Claims 2, 20, 21 and 23 have been canceled.

Each independent claim has been amended to point out aspects of the claimed invention. In particular, each independent claim requires that the said abrasive stones are made of a heat cured material comprising carbon, silicon, clay and resin.

III. No Prima Facie Case of Obviousness

In order for the references to form a basis of a rejection under 35 U.S.C. § 103(a), the references must disclose or suggest, each of the claimed elements of the independent claims. The prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* M.P.E.P. § 2142. *See also, In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991) (emphasizing that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure). As noted above, the independent claims have been amended to require that the said abrasive stones are made of a heat cured material comprising carbon, silicon, clay and resin. The references alone, or in combination do not teach this claim requirement.

Moreover, the Hopkins and reference teaches away from Applicant's claimed invention. Hopkins teaches the application of a film or layer of abrasive material to an underlying nonabrasive material. For example in Hopkins, the abrasive structure may be formed of a block of form-retaining material substantially impervious to aqueous washing systems and a resilient layer of synthetic abrasive material substantially surrounding the block and affixed to the exterior surfaces of the block. In the most preferred embodiments the structure is a rigid block of polypropylene. (*See* Hopkins, abstract and col. 2, lns 54-65.). Clearly, a film or layer of abrasive material applied to a block is not an artificial abrasive stone made of a heat cured material comprised of carbon, silicon, clay and resin.

Additionally, the mere fact that the prior art references could be modified in the manner proposed by the Examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification. *See, In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) and cases cited therein. A careful review of the references in their entirety, does not provide any express or implied suggestion that their collective teachings would have motivated the skilled artisan to combine them in the manner proposed in the office action.

In determining whether the differences between the claims at issue and the prior art are sufficiently minor to render the claimed invention obvious, it must be established whether one skilled in the art would have been motivated to select and combine features from each

cited reference in order to make the claimed invention at the time it was made. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). Thus, "when determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *In re Beattie*, 974 F.2d 1309, 1311-12, 24 U.S.P.Q.2D 1040, 1042 (Fed. Cir. 1992) (citations omitted). That knowledge can not come from the Applicant's invention itself. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 U.S.P.Q.2d 1315, 1318 (Fed. Cir. 1988).

Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims.

IV. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 06-2375, under Order No. HO-P02242US0.

Dated: *Sept. 20, 2004*

Respectfully submitted,

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